

Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
Q137-US9

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Application Number
10/665,509

Filed
September 17, 2003

First Named Inventor
TSUKAMOTO, Hisashi et al.

Signature _____

Art Unit
1795

Examiner
Keith Walker

Typed or printed
name _____

Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request if being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

Signature

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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Registration number if acting under 37 CFR 1.34. _____

3/12/2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

*Total of _____ forms are submitted.

This collection of information is required by 37 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



PATENT
Docket No. Q137-US9

RE THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Hisashi Tsukamoto et al.
Serial No: 10/665,509
Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY
CONSTRUCTION AND METHOD OF
MANUFACTURE

Art Unit: 1745
Examiner: WALKER, Keith D.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

This communication is in response to the Office Action mailed on December 13, 2007 (the pending Office Action). Claim 58 is the only independent claim that remains pending. Claim 58 stands rejected under 35 USC §102(e) and also under 35 USC §112, first paragraph. Additionally, claims 58, 59, and 66-87 stand rejected for double patenting. The Applicant submits that a clear legal error has been made in each of the above rejections.

REMARKS

Rejection of Claim 58 Under 35 USC §102(e)

Claim 58 is rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 5,501,916 (Teramoto).

To support this rejection, the December 13, 2007 Office Action relied on Teramoto's Figure 9 and associated text. In response, the Applicant pointed out that Teramoto's Figure 9 and associated text does not teach "an electrode (that) is electrically insulated from the pin but is in electrical communication with a second end cap." In response, the pending Office Action now cites Figures 1 and 2 of Teramoto. A review of claim 58 shows that claim 58 recites "a first end cap that seals a first opening in the case" and also "a second opening in the case; and sealing the second opening with the second end cap." Figure 2 of Teramoto does not teach a first end cap that seals a first opening in a case and a second end cap that seals a second opening in the case. Accordingly, Figure 2 of Teramoto also does not anticipate claim 58.

Rejection of Claims 58, 59, 66-87 Under 35 USC §112

Claims 58, 59, and 66-87 are rejected under 35 USC §112, first paragraph, as based on a disclosure which is not enabling. In particular, the Office Action argues that insulation of the pin from the case is critical to the operation of the claimed method and accordingly must be included in the claimed method.

Insulation of the pin from the case is not critical to the claimed method. For instance, in the battery of Applicant's Figure 20-22, consider the case being electrically insulating and the pin being in electrical communication with the case. In this case, the opposing end caps can be used as the terminals of the battery without the battery short-circuiting. This type of battery configuration is a common construction (an example of such a construction can be seen in paragraph 57 of U.S. Patent Application Publication number 2002/0001745). As a result, the claimed method can be practiced with the pin being in electrical communication with the case.

An embodiment of the battery having an electrically insulating case is consistent with Applicant's specification. For instance, the specification teaches the following:

“The battery case itself **GENERALLY** functions as the other battery terminal” (page 3, line 19-20, emphasis added).

The Applicant believed this teaching to be important enough to be included it in the “Summary of the Invention” section of the specification. Note the presence of the term **generally** in this citation. Since the term “generally” indicates a condition that is not always true, this sentence teaches that the case does not always function as the other terminal. When the case is electrically insulating as discussed in the above paragraph, the case does not serve as a terminal, exactly as taught in the above citation. Accordingly, a battery having an electrically insulating case is consistent with Applicant's specification.

The Examiner may elect to address the above argument by alleging that the specification does not specifically teach the battery details described above. However, this argument overlooks the legal standard required to support this rejection. As set forth in MPEP §2164.08(c), in order to support the pending rejection, the specification must teach that insulation of the pin from the case is critical to the claimed method. However, if the specification had taught criticality of insulating the pin from the case, the battery construction discussed above would NOT be consistent with the specification. To see this point, suppose

that the specification had stated that “insulation of the pin is critical to battery operation.” In that case, a battery having an un-insulated pin would be entirely inconsistent with the specification. That is not the case here as shown by the consistency between the above battery structure and the specification. Accordingly, the consistency of the described battery with the specification illustrates that the specification fails to teach criticality of insulating the pin from the case. Since the specification fails to teach criticality of insulating the pin from the case, the specification does not support the pending rejection and the rejection should be withdrawn for this reason alone.

In addition to the above argument, the above citation (P3, L19-20) directly shows that the specification fails to provide the teaching of criticality required to support this rejection. As discussed above, the specification teaches that the case does not always function as one of the terminals. When the case does not function as the other terminal, the pin can be in electrical communication with the case without shorting the battery. If the pin can be in electrical communication with the case without shorting the battery, then there is no reasonable argument that the specification teaches that it is critical for the pin to be insulated from the case. Since the specification fails to teach criticality of insulating the pin from the case, the specification does not support the pending rejection and the rejection should be withdrawn for this reason alone.

The Office Action Impermissibly Contradicts the Specification

The Examiner’s conclusion that it is critical for the pin to be insulated from the case relies on the conclusion that the case ALWAYS functions as the other terminal. This conclusion overlooks the term “generally” in the above citation (P3, L19-20). Additionally, when the previously filed amendment pointed out the presence of this term in the above citation, the responding Office Action did not address this term. However, the MPEP specifically prohibits ignoring particular teachings of the specification in order to make this rejection. For instance, MPEP §2164.08(c) provides that in “determining whether an unclaimed feature is critical, the entire disclosure MUST be considered.” As a result, the presence of the term “generally” in the above citation must be taken into consideration.

Since the Office Action must consider the presence of the term “generally” in the above citation, the Office Action must take into account the specification teaching that the

case does not always function as one of the terminals. However, the Office Action relies on the conclusion that the case ALWAYS functions as the other terminal. As a result, the Office Action directly contradicts the teachings of the specification. The second paragraph of MPEP §2164.04 specifically addresses conflicts between the specification and the examiner during enablement inquiries. As a result, this section of the MPEP is directly on point in the current inquiry. The critical part of MPEP §2164.04 provides that when the Patent Office chooses to contradict the teachings of the specification "it is incumbent upon the Patent Office ... to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." 439 F.2d at 224, 169 USPQ at 370.

No explanation has been presented as to why the Examiner doubts Applicant's teaching that the case does not always function as the other battery terminal. Additionally, no reasoning or evidence inconsistent with this teaching has been presented. Further, it seems unlikely that such evidence could be presented in light of the insulating battery case discussed above. Without the required explanation, the Office Action does not comply with the requirements of MPEP §2164.04 and it remains "presumptively accurate" (second paragraph of MPEP §2164.04) that the case does not always function as the other battery terminal. As noted above, when the case does not function as the other terminal, the pin can be in electrical communication with the case without shorting the battery. If the pin can be in electrical communication with the case, there is no reasonable argument that the specification teaches that it is critical for the pin to be insulated from the case. Since there is no reasonable argument that it is critical for the pin to be insulated from the case, the pending rejection is not supported and the rejection should be withdrawn.

Rejection of claims 58, 59, and 66-87 for double patenting over claims 66-91 of U.S. Patent Application serial number 10/666,379 (the '379 application).

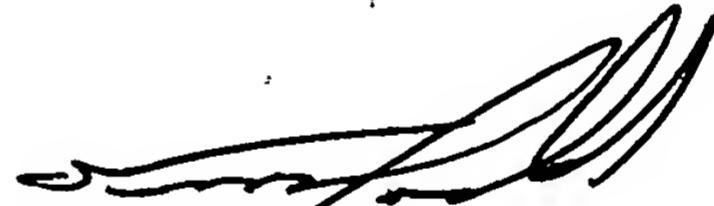
In the '379 application, an amendment was filed on 12/10/07. In response, a Notice of Allowance was mailed on 01/28/08. The issue fee has not yet been paid. Accordingly, the claims pending in the '379 application are the claims in the 12/10/07 Amendment.

Claims 66-91 of the '379 application do not teach or suggest "a pin extends from an interior of a case through a first end cap that seals a first opening in the case ... and sealing (a) second opening (of the case) with (a) second end cap" as is recited in currently pending claim 58. In particular, Claim 90 of the '379 application recites a tab connected to an end cap and the pin extending through that same end cap. However, claim 90 does not introduce another end cap as recited in the currently pending claims. Accordingly, claim 58 is patentable over claims 66-91 of the '379 application. Since pending claims 59, 66-87 each depends directly or indirectly from claim 58, these claims are also patentable over claims 66-91 of the '379 application. Since the currently pending claims are patentable over claims 66-91 of the '379 application, the double patenting rejection should be withdrawn.

Conclusion

The Applicant respectfully submits that legal error has been made in each of the above rejections. For these reasons, allowance of the currently pending claims is respectfully requested.

Respectfully submitted



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